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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/759,931 | 01/16/2004 | Karen A. Anders | AUS920030750US1 | 8212 |

7590 03/29/2006
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1201 Main Street
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EXAMINER

SHAH, AMEE A

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/759,931 | Applicant(s) ANDERS ET AL. | |
| | Examiner Amea A. Shah | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-25 are pending in this action.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4), (p)(5), (l), (m) and (q) because:

(1) reference character 212 has been used to designate both a program administrator (Specification, page 8) and part of the database (Fig. 2A);

(2) they do not include the reference sign “214” mentioned in the description;

(3) they include the reference character “510” not mentioned in the description;

(4) reference characters 704, 706, 708, 712 and 720 have been used to designate both recipients and geographical entities (Specification, pages 11-12);

(5) reference characters 714 and 716 have been used to designate both recipients and links (Specification, pages 11-12);

(6) they contain handwritten text that will not reproduce properly, *see* 37 CFR 1.84(l);

(7) they contain improper shading that does not aid in the understanding of the invention and will not reproduce properly, *see* 37 CFR 1.84(m); and

(8) they contain crossing lead lines (Fig. 1), *see* 37 CFR 1.84(q).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of

an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 8 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "wherein said substep of comparing a set of profile attributes values..." in lines 1-2 of the claims. There is insufficient antecedent basis for this limitation (profile attributes) in the claim. Since claim 8 is a dependency of claim 5, it inherits the same deficiency and is rejected on the same basis. For purposes of this action only, the Examiner will interpret the profile attribute to be the package attribute.

Claim 5 contains the limitation "if said attribute is single-valued..." (line 6 of claim). It is not clear to one of ordinary skill in the art whether the attribute is the profile attribute or the current attribute. Since claim 8 is a dependency of claim 5, it inherits the same deficiency and is rejected on the same basis. For purposes of this action only, the Examiner will interpret the attribute to be the current attribute.

Examiner Notes

(1) Examiner interprets claims 10-18 to be directed to a computer program product embodied in a tangible storage medium that is executable by a computer or processor, per the Specification (page 13, lines 1-20), and therefore is statutory under 35 U.S.C. §101.

(2) Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 9-13, 15, 18-22 and 25 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Svancarek et al., U.S. Pat. App. Pub. No. 2004/0039705 A1 (hereinafter referred to as “Svancarek et al.”).

Referring to claim 1. Svancarek et al. discloses a method for entitlement management comprising:

- responsive to a request for a service (page 3, ¶0031), determining if a recipient identified in said request is entitled to said service (page 4, ¶0034);
- if said recipient is entitled to said service, delivering said service (page 4, ¶0036),
- wherein said step of determining if said recipient is entitled to said service comprises comparing a set of administrator-configurable package attributes values associated with a package of services containing said service with corresponding values for said recipient (page 4, ¶0034 – note the attributes are contained in the eligibility service and can be a participating region or participating software product).

Referring to claim 2. Svancarek et al. also discloses the method of claim 1 further comprising if, responsive to said determining step, if said recipient is not entitled, sending a message to said recipient indicating said recipient is not entitled to said service (pages 3-4, ¶¶0031, 0032 and 0035).

Referring to claim 3. Svancarek et al. also discloses the method of claim 1 further comprising configuring said set of package attributes wherein said set of package attributes includes selected attributes having one or more attribute values (page 4, ¶¶0034, 0036 and 0037).

Referring to claim 4. Svancarek et al. also discloses the method of claim 1 further comprising:

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- determining if said service includes a limited number of accesses (pages 4 and 5, ¶¶0035 and 0042 – note the limited number of accesses is if the key was already used); and
- if said service includes a limited number of accesses, decrementing a tracking count associated with the service (page 5, ¶¶0042-0043).

Referring to claim 6. Svancarek et al. further discloses the method of claim 2 wherein the step of sending said message comprises presenting said recipient with alternate content (page 4, ¶¶0032-0033 – note the alternate content is the website to which the user is redirected).

Referring to claim 9. Svancarek et al. also discloses the method of claim 4 further comprising:

- logging a delivery of said service (Fig. 3 and pages 4-5, ¶¶0040-0042);
- decrementing a number of available instances of said service if said service has a limited usage count (Fig. 3 and page 5, ¶0042); and
- sending a message to said recipient indicating said recipient is not entitled to said service if the limited usage count has been consumed (page 4, ¶0035).

Referring to claims 10-13, 15, 18-22 and 25. All of the limitations in apparatus claims 10-13, 15, 18-22 and 25 are closely parallel to the limitations of method claims 1-4, 6 and 9, analyzed above and are rejected on the same bases.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8, 14, 17, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svancarek et al. over Talbot et al., U.S. Pat. App. Pub. No. 2002/0116312 A1 (hereinafter referred to as “Talbot et al.”)

Referring to claims 5 and 8. Svancarek et al. discloses the method of claim 1, as discussed above, wherein said substep of comparing a set of profile attributes values associated with a package of services containing said service with corresponding values for said recipient comprises determining said recipient is not entitled if a or each value of said current attribute and a corresponding value for said recipient miscompare (page 4, ¶0034). Svancarek et al. does not expressly show determining if the current attribute is single-valued or not. Talbot et al., in the same field of endeavor of e-shopping, discloses a reverse blind credit auction between a borrower and at least one lender to which the borrower is matched using various criteria, including determining if the attribute value is single-valued or not (Talbot et al., page 4, ¶¶0043-0044 – note the attribute is the exclusion).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Svancarek et al. to include the teachings of Talbot et al. to allow for determining whether the current attribute is single-valued or not. Doing so would

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allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria, as suggested by Talbot et al. (page 2, ¶0012).

Referring to claims 14, 17, 23 and 24. All of the limitations in apparatus claims 14, 17, 23 and 24 are closely parallel to the limitations of method claims 5 and 8, analyzed above and are rejected on the same bases.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svancarek et al.

Referring to claim 7. Svancarek et al. discloses the method of claim 6, as discussed above, but does not explicitly disclose wherein said alternate content includes a description of criteria for said requested service. As analyzed above, Svancarek et al. shows presenting the recipient with alternate content when the recipient is not entitled to the requested service. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the presenting step recited. The data to be displayed when the recipient is found ineligible does not change the function being performed. The presenting of alternate content would be performed in the same manner regardless of the exact composition of the content, whether a message, an alternate website or a description of criteria. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Svancarek et al. in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to present alternate content obtain when the recipient is ineligible for the service regardless of the specific composition of the content, whether a message, an alternate website or a description of criteria, because such content does not functionally relate to presenting step and also because the content to be displayed does not patentably distinguish the claimed invention.

Referring to claim 16. All of the limitations in apparatus claim 16 are closely parallel to the limitations of method claim 7, analyzed above and are rejected on the same bases.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Blumofe, U.S. Pat. App. Pub. No. 2001/0025260 A1, discloses a method and system for e-commerce subscription service including determining if a requester of the service is eligible for receiving the periodical based on a number of usages, if do, then delivering the periodical, logging the usage, decrementing the number of usages, and sending the user messages if not entitled to access of if the usage limit has been reached (see, e.g., pages 2-5).

(2) Dutta et al., U.S. Pat. App. Pub. No. 2003/0061111 A1, discloses a method and system for providing an authorizer with electronic control over e-transactions by another, including determining if the e-transaction is within specified parameters set by the authorizer, performing the transaction if it is, and informing the shopper of the criteria if it is not (see, e.g., pages 4-6).

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(3) Shim, U.S. Pat. No. 6,609,107 B1, discloses a method and system for operating a duty-free shopping mall, including determining if the shopper is eligible for the duty-free shopping service, allowing the shopping transaction if he is, and informing him if he is not (see, e.g., cols. 3-5).

(4) Umbreit, U.S. Pat. No. 6,704,787 B1, discloses a method and system for issuing access codes for requested services including determining if users are authorized to obtain a service based on configurable attributes such as age, geography and other demographics, delivering the service if authorized and displaying criteria and other content if not authorized (see, e.g., cols. 2-9).

(5) Gilbert, U.S. Pat. No. 6,968,385 B1, discloses methods and systems for providing limited temporary access to a web site, including determining if the user is eligible to visit the website based on a limited number of usages, if so, then allowing access to the website, logging the access to the website, decrementing the number of usages, and sending the user messages if not entitled to access or if the usage limit has been reached (see, e.g., cols. 2-8).

(6) Agraharam et al., EP 0808048 A2, discloses a system for restricting access to multimedia including determining if the requester is authorized to the service by comparing his values to attributes and delivering the service if he is authorized (see, e.g., cols. 3-7).

(7) Savage, Marcia, "Computer Associates Enters Web Access Management Arena," CRN, Jericho, Dec. 2, 2002, Iss. 1023, pg. 78, discloses a system for restricting access to the Internet limiting users only to authorized data.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ameer A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rob Pond can be reached on 571-272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

March 27, 2006


Y. C. Gang
Primary Ex